

REMARKS

SPECIFICATION OBJECTION

The present Office Action object to the specification because the Serial Number of the Provisional Application is left blank. Applicant has submitted a new paragraph 1 to correct this. Applicant respectfully submits that Amended Paragraph 1 contains the Serial Number of the Provisional Application and sufficiently overcomes the objection of the present Office Action.

CLAIM REJECTIONS

Claims 2 – 10 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-3, 6-19, 22-27 and 30-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Shwarts (U.S. Patent No. 6,144,380) and Weeren (U.S. Patent No. 6,501,956). Claims 4-5, 20-21 and 28-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Shwarts (U.S. Patent No. 6,144,380), Weeren (U.S. Patent No. 6,501,956) and Nielsen (U.S. Patent No. 5,854,630). Applicant respectfully traverses these rejections for at least the following reasons.

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 2 – 10 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection for at least the following reasons.

35 U.S.C. § 112, second paragraph recites “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” The present Office Action rejects Claim 2 as indefinite because it depends on itself. Applicant respectfully submits that amended Claim 2 has set forth the appropriate dependency on Claim 1. Applicant respectfully submits that amended Claim 2 overcomes this rejection. Further, the present Office Action rejects Claims 3-10 because of their ultimate dependency on Claim 2. Applicant respectfully submits that the rejection of Claims 3-10 is similarly overcome by Applicant’s amended Claim 2.

REJECTION UNDER 35 U.S.C. § 103(a)

Claims 1-3, 6-19, 22-27 and 30-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Shwarts (U.S. Patent No. 6,144,380) and Weeren (U.S. Patent No. 6,501,956). Claims 4-5, 20-21 and 28-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Shwarts (U.S. Patent No. 6,144,380), Weeren (U.S. Patent No. 6,501,956) and Nielsen (U.S. Patent No. 5,854,630). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *MPEP 706.02(j)*.

A. Independent Claims

The present Office Action has rejected independent Claims 1, 27, 35 and 36. Applicant respectfully submits that the present Office Action fails to address at least the element, in claim 1, of "making a first deck having a plurality of cards available to the wireless communication device for display thereon." *Original Claim 1*. Applicant respectfully submits that at least this element is not taught, nor does the present Office Action suggest this element is taught, by the combination of Shwarts and Weeren.

Applicant further respectfully submits that the present Office Action fails to address at least the element of “storing the sequence of displayed cards in a memory associated with the server computer.” *Original Claim 27*. Applicant respectfully submits that at least this element is not taught, nor does the present Office Action suggest that this element is taught, by the combination of Shwarts and Weeren.

Applicant further respectfully submits that the present Office Action fails to address at least the elements of “determining a current card, and a set of previously visited cards.” *Original Claim 35 and Original Claim 36*. Applicant respectfully submits that at least this element is not taught, nor does the present Office Action suggest that this element is taught, by the combination of Shwarts and Weeren.

Applicant requests Examiner specifically point out the portions of the art that Examiner relies upon in rejecting each element of each of the claims. Such a complete rejection would provide the Applicant with the appropriate and required opportunity to examine the rejections set forth. Applicant respectfully submits that the present Office Action does not provide the Applicant with the appropriate opportunity to respond to the rejections at least for the reasons highlighted above for each of the independent claims.

Applicant respectfully submits that the requirements of 35 U.S.C. § 103 were not met by the present rejection in that each claimed element was not properly rejected. See, MPEP § 706.02(j) (“103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference, or to combine it with one or more other references.... (A) the relevant teachings of the prior art relied upon [for each element of the claimed subject matter]... (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter.... It is important for an examiner to

properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given a fair opportunity to reply.”) [Comments added.]

As such, Applicant respectfully submits that Claims 1, 27, 35 and 36 are patentably distinguishable over the cited art, at least for the foregoing reasons.

B. Dependent Claims

Applicant respectfully submits that Claims 2 – 26 and 28-34 are not obvious under § 103(a) as being unpatentable over the cited art, at least by virtue of these claims’ ultimate dependency upon a patentable base claim, namely Claims 1 and 27, respectively.

CONCLUSION

Wherefore, Applicant believes he has addressed all outstanding grounds raised by Examiner and respectfully submits that the present case is in condition for allowance, early notification of which is earnestly solicited.

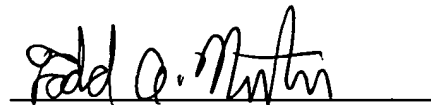
Alternatively, should Examiner persist in any of the foregoing rejections, Applicant respectfully requests that Examiner: specifically identify and point out with particularity those exacting elements taught by the prior art references upon which Examiner relies for teaching each claimed element of each rejected claim; and, identify those particular portions of the prior art references upon which Examiner relies for

support, so Applicant may be afforded an appropriate opportunity to deliberate and respond to any such rejection.

Should there be any questions or outstanding matters, Examiner is cordially invited and requested to contact Applicant's undersigned attorney at his number listed below.

Respectfully Submitted,

REED SMITH LLP

A handwritten signature in black ink, appearing to read "Todd A. Norton", is written over a horizontal line.

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